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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,886	03/13/2006	Donald Robert Langdon	2003CH201	2678
25255 7590 06/12/2008 CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			EXAMINER TAYLOR II, JAMES W	
			ART UNIT	PAPER NUMBER
			4171	
			MAIL DATE	DELIVERY MODE
			06/12/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/571,886

**Applicant(s)**

LANGDON ET AL.

**Examiner**

James W. Taylor II

**Art Unit**

4171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/4/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 and 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 and 18-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date 6/15/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11, drawn to the composition.

Group II, claim(s) 12-16, drawn to an article.

Group III, claim(s) 18-31, drawn to a method of making an article.

*A priori* unity of intention is established for the instant application as there is a common thread between the instant claims:

- (i) a polymeric material,
- (ii) mica or micaceous material,
- (iii) a metal sulphide, and
- (iv) one or more non-black organic pigments.

However, upon a general search for the invention of the instant claim 1, the examiner found Hartman *et alli* (US 6019833). Hartman *et alli* teaches components (i), (ii), (iii), and (iv) as saturated polyesters (c. 2, l. 2), metal oxide encapsulated mica (c. 5, ll. 26-27), zinc sulfide (c. 2, l. 31), and phthalocyanine blue (c. 5, l. 25), respectively.

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Therefore, the common thread between the claims is anticipated, which necessitates a *posteriori* lack of unity.

During a telephone conversation with Mr. Anthony A. Bisulca on June 6, 2008 a provisional election was made **with traverse** to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-16 and 18-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartman *et alii*.

In claim 1, the applicant claims:

- (i) a polymeric material (corresponding to "saturated polyesters," Hartman *et alii*, c. 2, I. 2),
- (ii) mica or micaceous material (corresponding to "metal oxide encapsulated mica," Hartman *et alii*, c. 5, II. 26-27),

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(iii) a metal sulphide (corresponding to "zinc sulfide," Hartman *et alli*, c. 2, l. 31), and

(iv) one or more non-black organic pigments (corresponding to "phthalocyanine blue," Hartman *et alli*, c. 5, l. 25).

Regarding claim 11, the applicant further claims that the amount of component (iv) is from 0.01 to 10.0 wt. % relative to the entire composition (corresponding to "0.5 to 25 %," Hartman *et alli*, c. 5, l. 30).

Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoen *et alli* (2002/0192448).

In claim 1, the applicant claims:

- (i) a polymeric material (Schoen *et alli*, par. 46),
- (ii) mica or micaceous material (corresponding to "metal oxide coated mica," Schoen *et alli*, par. 48),
- (iii) a metal sulphide (corresponding to "cadmium sulfides," Schoen *et alli*, par. 28), and
- (iv) one or more non-black organic pigments (corresponding to "carmine red," Schoen *et alli*, par. 28).

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Knight *et alli* (US 4267229).

- (i) a polymeric material (corresponding to "acrylic sheet," Knight *et alli*, ab.; c. 1, l. 5),
- (ii) mica or micaceous material (corresponding to "titanium dioxide ... treated mica platelets," Knight *et alli*, c. 4, ll. 7-8),
- (iii) a metal sulphide (corresponding to "cadmium sulfide," Knight *et alli*, c. 4, l. 20), and
- (iv) one or more non-black organic pigments (Knight *et alli*, c. 4, l. 10; corresponding to "quinacridone red," c. 5, ll. 41-42).

Regarding claim 3, the applicant further claim that a metal oxide is used to coat component (ii), wherein the metal oxide is selected from the group consisting of: antimony oxide, titanium oxide, and/or tin oxide. The examiner takes the position that this language is not intended to limit the applicant's invention to metal oxides of a 1 to 1 stoichiometric ratio as the instant specification (p. 4, ll. 16-18) does not limit or comment on the stoichiometric ratio. Hence, titanium dioxide meets the limitation imposed by claim 3.

Regarding claim 6, the applicant claims that component (ii) is present in the amount from 0.05 to 2% wt. % (Knight *et alli*, c. 5, ll. 11-13).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 8-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Schoen *et alli*, as applied to claims 1-2 and 4 above.

In claims 6 and 8-11, the applicant claims specific amounts of components (ii) and (iii).

Schoen *et alli* teaches each of these components. Furthermore, the document also teaches that these pigments have uses in laser marking.

Schoen *et alli* fails to teach the ranges of components (ii) and (iii) that are claimed by the applicant.

The examiner takes the position that the concentrations of these pigments are result-effective variables. Therefore, the amounts of the pigments present in the end product are purely optimization. A *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *In re* Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (MPEP 2144.05).

Therefore, to a person having ordinary skill in the art at the time of invention, it would have been obvious to select a specific range of components (ii) and (iii) to optimize the color for a particular environment or preference.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Taylor II whose telephone number is (571) 270-5457. The examiner can normally be reached on 7:30 am to 5:00 pm (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/  
Supervisory Patent Examiner, Art Unit 4171

James W Taylor II  
Examiner  
Art Unit 4171

jwt2